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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,515	03/15/2001	Cheng Zhou	81560.925	6192
33438	7590	03/24/2005	EXAMINER	
HAMILTON & TERRILE, LLP P.O. BOX 203518 AUSTIN, TX 78720			VIG, NARESH	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/810,515

Applicant(s)

ZHOU ET AL.

Examiner

Naresh Vig

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-74 is/are rejected.
- 7) ☒ Claim(s) 11,12 and 68 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20010823</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 11, 12 and 68 are objected to because of the following informalities:

There are 2 sets of claims 11 and 12. Examiner is reading second set as claims 73 and 74.

Claim 68 is a computer program claiming dependency on claim 30 which is a method claim. Examiner reads claim 68 as claiming dependency on claim 67.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Art Unit: 3629

Claims 1 – 74 are rejected under 35 U.S.C. 102(a) as being anticipated by Verisoft, Inc. hereinafter known as ZipForm.

Regarding claims 1 and 35, ZipForm teaches computer system, program and method in a computer system for generating documents (internet connectivity feature gives users the opportunity to access forms revisions and software updates via the web [page 5]. ZipForm teaches:

obtaining at least one of a plurality of components from a document template (capability to convert preprinted form to electronic form) [page 8].

obtaining at least one relationship from said document template, said relationship defining an association between said plurality of components and a document to be generated (Form Grouping) [page 5];

generating said document according to said at least one relationship; providing said document to a user [page 5 – 7].

Regarding claims 15 and 52, ZipForm teaches computer system, program and method in a computer system for generating documents (internet connectivity feature gives users the opportunity to access forms revisions and software updates via the web [page 5]. ZipForm teaches:

obtaining at least one compensation component from a document template wherein said at least one compensation component is associated with at least one product (business choice to elect contents of the document) [page 5 – 7];

Art Unit: 3629

obtaining at least one textual component from a document template, wherein said at least one textual component comprises textual elements (capability to convert preprinted form to electronic form) [page 8].

obtaining at least one relationship that defines an interrelationship between said at least one compensation component or said at least one textual component and a document to be generated (Form Grouping) [page 5];

generating said document associated with said product according to said at least one relationship [page 5 – 7].

Regarding claims 29 and 66, ZipForm teaches computer system, program and method in a computer system for enabling a user to define configurable documents (let ZipForm convert your preprinted real estate forms to electronic forms with .... Custom Forms Design Service, it is inherent that, and allows users to fill the forms) [page 5 – 8].

ZipForm teaches:

presenting a modeling interface to a user (forms can be grouped, teaches document conversion service);

obtaining modeling information from said user via said modeling interface (pre-printed forms from customers);

generating at least one compensation plan from said modeling information (Business choice to elect content of the forms);

generating at least one compensation component by creating a relation between said at least one compensation plan and at least one product, said association

Art Unit: 3629

representative of said at least one product said user wishes to distribute (business choice to elect the structure of the compensation, for example fixed commission, or, variable commission based upon the sale price etc.);

obtaining at least one textual element (form used for information purpose only, for example, Lead Based Booklet etc.)

generating at least one textual component comprising said at least one textual element by creating a relation between said at least one textual component and said at least one product (a contract may have additional addendums);

associating said at least one compensation component and said at least one textual component with a document template (design choice for contents of the document, for example, commission structure may be part of the contract, or, a business may elect put commission structure as an addendum to the contract).

Regarding claims 2 and 36, ZipForm teaches configuration engine performs said generating said document [page 5 – 7].

Regarding claims 3 and 37, ZipForm teaches at least one of said plurality of components comprises a compensation component (business choice, ZipForm teaches to cater to Real Estate, and, it is inherent that Real Estate contracts have commissions as compensation to the real estate agent documented on the contracts).

Regarding claims 4, 17, 38 and 54, ZipForm teaches as responded to earlier in response to claim 3, ZipForm teaches commission associated with the sale of a product (business choice to elect how to pay commission).

Regarding claims 5, 18, 39 and 55, as responded to earlier in response to claim 4, ZipForm teaches monetary compensation to be distributed to a sales representative (business choice to elect how to pay commission).

Regarding claims 6, 19, 40 and 56, as responded to earlier in response to claim 3, ZipForm teaches compensation component is modeled using a commission model (business choice to elect how to pay commission, e.g, fixed commission, variable rate commission etc.).

Regarding claims 7 and 41, ZipForm teaches plurality of components comprises a textual component [page 5 – 7].

Regarding claims 8, 20, 42 and 57, ZipForm teaches textual component comprises pre-defined textual elements [page 5 – 7].

Regarding claims 9 and 43, ZipForm teaches pre-defined textual elements are generated by a third-party (business choice to elect to outsource creation of documents) [page 5 – 7].

Regarding claims 10, 21, 44 and 58, ZipForm teaches textual component is associated with a product (business choice to elect purpose of the document) [page 5 – 7].

Regarding claims 11, 45 and 46, ZipForm teaches document comprises a contract [page 5 – 7].

Regarding claims 12, 24, 47 and 61, ZipForm teaches plurality of components are defined as a standard component, required component, or optional component (design choice, form grouping, for example, along with the contract set of region specific addendums are added to the contract) [page 5 – 7].

Regarding claims 73 – 74, 13 – 14, 25 – 28, 48 – 51, 32 – 34, 62 – 65 and 69 - 72, as responded to earlier in response to claims 1 and 12, ZipForm teaches

interrelationship comprises an excludes relation.

interrelationship comprises a requires relation.

interrelationship comprises an optional relation.

Regarding claims 16 and 53, ZipForm teaches configuration engine performs said generating said document associated with said product (field of use, ZipForm



Art Unit: 3629

teaches customer can print contract, and it is inherent that contracts can have plurality of attached addendums) [page 5 – 7].

Regarding claims 22 and 59, ZipForm teaches document comprises a contract [page 5 – 7].

Regarding claims 23 and 60, ZipForm teaches textual components are defined by a first user (business choice to elect whether to product the document in-house or outsource the creation of documents)..

Regarding claims 30 and 67, as responded to earlier in response to claim 29, ZipForm teaches:

providing said document template to a configuration engine (Custom Form Design Service, conversion of pre-printed forms to electronic forms etc.) [page 8];

processing of said document template at said configuration engine to generate a document (user can print contract) [page 5 – 7].

Regarding claims 31 and 68, as responded to earlier in response to claim 29, ZipForm teaches:

obtaining one or more relations associated with said at least one compensation component and said at least one textual component from said document template (business choice to elect compensation structure);

Art Unit: 3629

applying said one or more relations to generate a document (user can fill in the information to complete the form) [page 5 – 7];

providing said document (user can print the document) [page 5 – 7].

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

1. Hsu et al. US Patent 6,377,956
2. Cornelia et al. US Patent 6,065,026
3. Smith et al. US Patent 5,181,162

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is 703.305.3372. The examiner can normally be reached on M-F 7:30 - 5:00 (Alt Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308.2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3629

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Naresh Vig", with a stylized flourish at the end.

Naresh Vig  
Patent Examiner  
March 19, 2005